

Our ref: E-1048

Client's ref: E-1048.0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

-----X

In re Application of: G. Schmaucks : Examiner: Darcy D.
LACLAIR

Appln. No. : 10/517,126 : Art Unit: 1796

Title: ELASTOMERIC RESIN : Dated: October 21,
COMPOSITIONS 2010

Filing Date: March 8, 2006

-----X
Confirmation #: 2783

CERTIFICATE

I hereby certify that this correspondence is being EFS-Web or facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 21, 2010

LUCAS & MERCANTI, LLP

BY: Donald C. Lucas

Donald C. Lucas, Reg. #31,275

RESPONSE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

OK TO ENTER: /D.L./

S i r:

This is in response to the final Office Action, dated July 21, 2010, in the above-identified Application. Attached hereto is the Remarks starting on a separate page.

REMARKS

A. Request for Reconsideration

Applicant has carefully considered the matters raised by the Examiner in the outstanding Final Office Action but remains of the position that patentable subject matter is present. Applicant respectfully requests reconsideration of the Examiner's position based on the following remarks.

B. Claim Status

Claims 4-7, 9 and 10 are pending in the application.

C. Obviousness-Type Double Patenting Rejection

Claims 4-7 and 9-10 had been provisionally rejected as being obvious in view of claims 1-8 of copending Application No. 11/718,590.

Applicant requests that the Examiner hold this obviousness-type double patenting rejection in abeyance until this case is ready for allowance.

D. The Invention

The presently claimed invention is directed to a

method for production of a highly filled elastomeric compound by forming an elastomeric resin with a high filler content and by adding a microsilica to it (e.g., page 2, lines 20-24).

The advantages of the presently claimed method are the unexpected properties of low viscosity and good processability of the highly filled elastomeric compounds (e.g., page 3, lines 16-19). It is well known in the art that elastomeric compounds with high filler loadings have increased compound viscosity which leads to poor processability and scorch safety (e.g., page 1, lines 8-19).

As disclosed in the specification, one of the disadvantages of highly filled elastomeric compounds is that high filler loading increases the viscosity to such a level that the compound cannot be processed. The presently claimed invention solves this processability problem by adding 1% to 400% by weight of microsilica to a highly loaded elastomeric compound.

E. Claim Rejections under 35 USC § 103(a)

The Examiner has maintained the rejection of claims 4-7, 9 and 10 under 35 USC 103(a) as being unpatentable over Underwood in view of Emmett.

Underwood does not disclose Applicant's invention. Underwood simply provides for a resin composition loaded with particulate amorphous silica. Further, Underwood's Table 3 describes three different formulations (i.e., Formulation A, B and C), none of which provides for a resin composition containing high filler loading in addition to microsilica. Underwood simply shows a resin composition alone (Formulation A), combination of resin composition with silica (Formulation B), and resin composition with conventional filler (Formulation C). In other words, Underwood is completely silent regarding the method of adding microsilica to an already highly filled resin composition.

Emmett does not make up for Underwood's deficiencies because it suffers from the same defects. Emmet simply provides for a study of different combinations of butadiene acrylonite and polyvinyl chloride resins. Also, Emmet is

completely silent with regard to highly filled elastomeric compounds.

Accordingly, Applicant respectfully submits that the combination of Underwood with Emmett cannot render obvious the claimed subject matter to one skilled in the art.

First, none of the two references, alone or in combination, teaches a highly filled elastomeric compound. Second, as discussed above and as known in the art, functional fillers such as silica alone increase compound viscosity leading to poor processability. Thus, for all these reasons, it is respectfully submitted that the claimed subject matter is not rendered obvious by the combination of Underwood with Emmett and withdrawal of the rejection of claims 4-7, and 9-10 is respectfully requested.

Claims 4-7, 9 and 10 had been rejected under 35 U.S.C. 103(a) as being unpatentable over Černac et al. (WO 01/8055, hereinafter "Černac") in view of Underwood.

Černac does not disclose the presently claimed

invention. Černac also does not teach or suggest the claimed method of forming a highly filled elastomeric compound by adding microsilica to a highly filled elastomeric compound. Černac simply provides for a composition of polyamide fibers, powder graphite, mineral fillers, elastomeric binders, vulcanization system in paste form and auxiliary substances (e.g., paragraph bridging pages 2-3). Černac is completely silent with regard to highly filled elastomeric compounds.

Underwood, as discussed above, does not cure Černac's deficiency because Underwood does not teach the addition of microsilica to a highly filled elastomeric compound. Thus, the combination of Černac with Underwood also fails to render obvious the claimed subject matter.

Accordingly, for all the reasons set forth above, Applicant respectfully requests that the rejection of claims 4-7, and 9-10 be reconsidered and withdrawn.

For all of these reasons, reconsideration and withdrawal of this ground of rejection is respectfully requested.

G. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit account #02-2275.

Respectfully submitted,

LUCAS AND MERCANTI, LLP

By: Donald C Lucas
Donald C. Lucas, Reg. # 31,275
(Attorney for Applicant)
475 Park Avenue South
New York, New York 10016
Tel. # (212) 661-8000

DCL/EL